

Remarks

Claims 1-22 are pending for the Examiner's consideration, including amended claims 1, 4, 5, 7, 8, 11 and 18, as well as new claims 21 and 22. No new matter is believed to have been added. Claim 4 stands withdrawn from consideration.

Objection to the Specification

In the Office Action, the specification was objected to as failing to provide proper antecedent basis for the recitation in claim 16 of "a silver layer abutting an antireflection dielectric layer." However, Applicants draw the Examiner's attention to the specification at page 3, lines 26-27 stating that "[a] silver layer may abut an antireflection dielectric layer." Moreover, the specification states at page 7, lines 3-6 that "[p]referably, surface coating 5 is a thin, multilayer film system having two functional layers made of silver, as well as stop and antireflection dielectric layers which are placed above, below and between the silver layers." Thus, Applicants believe that the objection should be withdrawn.

Rejections Under 35 U.S.C. § 112, ¶ 2

Claims 1-3 and 5-20 were rejected in the Office Action under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that "[w]ith respect to claims 1 and 18, it is unclear as to what is meant by the protective coating 'covering...at least an external boundary edge of the transparent surface coating.'" The Office Action also states that "[w]ith respect to claim 11, it is unclear as to what is meant by 'the transparent surface coating being removed proximate at least one edge of the coated pane in a region between about 0.1-5 mm from a peripheral edge of the pane along a main surface of the pane.'" In response, claims 1, 11 and 18 have been amended for clarification purposes, and Applicants believe that the § 112, ¶ 2 rejections have been overcome.

Finally, with respect to claim 16, the Office Action states that "it is unclear what is meant by the silver layer abutting an antireflection dielectric layer." As discussed above with respect to the objection to the specification, Applicants believe that the term "abutting" is adequately disclosed in the application, and moreover that the meaning of the term "abutting" is well known. Thus, Applicants traverse the § 112, ¶ 2 rejection with respect to claim 16. Applicants respectfully submit that no amendment of claim 16 is necessary for clarification of this term.

Rejections Under 35 U.S.C. § 103(a)

In the Office Action, claims 1, 5, 7, 9 and 11-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,999,136 to Winter *et al.* ("Winter") in view of U.S. Patent No. 4,994,650 to Koontz ("Koontz") and U.S. Patent No. 5,131,967 to Tweadey, II *et al.* ("Tweadey"). The rejection respectfully is traversed.

The Office Action states:

Winter teaches . . . applying a protective layer 124 near the peripheral edge of the coated pane wherein the protective layer is impermeable to diffusion of water vapor and covers a portion of the uncoated region of the pane and a portion of the coated region of the pane. (Figure 3; column 4, lines 14-20 and 29-32; column 5, lines 23-25).

Applicants respectfully disagree with the Examiner's characterization of Winter. Instead, as understood, Winter fails to teach or suggest a protective layer being substantially impermeable to diffusion of water vapor and covering at least a portion of the exposed region of the coated pane and extending across a portion of the transparent surface coating beyond an edge thereof proximate the peripheral edge of the pane, as recited in amended independent claim 1. Nor does Winter teach or suggest a transition region extending between coated and uncoated regions of the main surface of the pane being covered with a protective layer impermeable to diffusion of water vapor, as recited in amended independent claim 11. Nor does Winter teach or suggest a protective coating being substantially impermeable to diffusion of water vapor and covering at least a portion of the exposed region of the first pane and extending across a portion of the transparent surface coating beyond an edge thereof proximate the at least one peripheral edge of the pane, as recited in amended independent claim 18. As understood, no such teaching or suggestion can be discerned from the portions of Winter cited by the Examiner. Moreover, as understood, neither Koontz nor Tweady rectify this deficiency.

Because claims 5, 7 and 9 depend from amended independent claim 1, claims 12-17 depend from amended independent claim 11, and claim 19 depends from amended independent claim 18, it is submitted that these claims at least are patentable not only because of the patentability of the independent claim from which they depend but also for the totality of features recited respectively therein.

Claims 2-3 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Winter, Koontz, and Tweadey, and further in view of DE 2344616 to Eisenführ *et al.* ("Eisenführ") and DE 19632240 to Siegfried Glaser ("Siegfried"). In addition, claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Winter, Koontz, and Tweadey, and further in view of U.S. Patent No. 5,030,503 to Carter *et al.*

("Carter"). Also, claims 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Winter, Koontz, and Tweadey, and further in view of U.S. Patent No. 5,099,105 to Goerenz *et al.* ("Goerenz"). Because claims 2-3, 6 and 10 amended in dependent claim 1, claim 20 depends from amended independent claim 18, it is submitted that these claims at least are patentable not only because of the patentability of the independent claim from which they depend but also for the totality of features recited respectively therein.

In the Office Action, claims 1, 5, 7-10 and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tweadey in view of Goerenz and U.S. Patent No. 5,334,412 to Korn *et al.* ("Korn"). This rejection respectfully is traversed.

The Office Action states that with respect to Tweadey, "The reference is silent as to applying the protective layer near the peripheral edge of the coated pane after removal of the coating wherein the protective layer is substantially impermeable to diffusion of water vapor and covering at least a portion of the exposed region of the coated pane and an external boundary edge of the coating." But, the Office Action states that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the decorative frame of Goerenz to the coated pane of Tweadey after removal of the coating such that the decorative frame and coating abut so as that the frame covers the uncoated region of the pane and the external boundary edge of the coating because such is known in the art, as taught by Korn." Applicants respectfully disagree.

First, Tweadey discloses:

It will be understood by those skilled in the art in view of the present discussion, that progression of any edge corrosion which occurs in remaining portion 22 would be inhibited by the laminating bond between the PVB laminating ply 26 and the substrate ply 12 in area 24. As best seen in FIG. 2, the PVB ply 26 is in substantially direct or immediate contact with surface 18 of substrate ply 12 in the area 24 from which the film stack 16 has been removed.

(Tweadey, Col. 6, lines 56-64).

As understood, the PVB laminating ply 26 in Tweadey is disposed substantially across the entire surface of windshield 10 (see, e.g., Fig. 1). Thus, the PVB laminating ply in Tweadey would be transparent or otherwise *not* opaque. In contrast, the invention as claimed in amended independent claim 1 recites, *inter alia*, an opaque protective layer, and the invention as claimed in amended independent claim 18 recites, *inter alia*, a ceramic protective coating. Moreover although the Examiner suggests that "it would have been obvious . . . to apply the decorative frame of Goerenz to the coated pane of Tweadey," there is no motivation from Goerenz or Tweadey to make such a combination. In particular, Tweadey provides a

laminating bond between VB laminating ply 26 and substrate ply 12, thereby obviating the need for the decorative film of Goerenz to serve such a purpose.

Moreover, none of the cited references, alone or in combination, suggests the process of amended independent claim 1 comprising, *inter alia*, a pane with a transparent surface coating and an opaque protective layer, with the protective layer covering at least a portion of the exposed region of the coated pane and extending across a portion of the transparent surface coating beyond an edge thereof proximate the peripheral edge of the pane. Further, none of the cited references, alone or in combination, suggests the process of amended independent claim 18 comprising, *inter alia*, a first pane with a transparent surface coating and a ceramic protective coating, with the protective coating covering at least a portion of the first pane and extending across a portion of the transparent surface coating beyond an edge thereof proximate the at least one peripheral edge of the pane.

In the Office Action, claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tweadey, Goerenz, and Korn, and further in view of Eisenfphr and Siegfried. Because claims 2 and 3 depend from amended independent claim 1, it is submitted that these claims at least are patentable not only because of the patentability of the independent claim from which they depend but also for the totality of features recited respectively therein.

In the Office Action, claims 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tweadey in view of U.S. Patent No. 5,320,893 to Floyd ("Floyd"). This rejection respectfully is traversed.

The Office Action states that "Tweadey teaches . . . applying an adhesive PVB layer" and that "the present invention includes a protective layer." As discussed above, however, amended independent claim 18 recites, *inter alia*, a first pane with a transparent surface coating and a *ceramic* protective coating, with the protective coating covering at least a portion of the exposed region of the first pane and of the transparent surface coating beyond an edge thereof proximate the at least one peripheral edge of the pane. Thus, the combination of Tweadey and Floyd fails to render obvious claim 18 or its dependent claim 19.

Finally, claim 20 was rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Tweadey and Floyd, and further in view of Goerenz. Applicants submit that because claim 20 depends from amended independent claim 18, this claim at least is patentable not only because of the patentability of the independent claim from which it depends but also for the totality of features recited respectively therein.

In view of the foregoing, it is believed that all the pending claims are in condition for allowance, which is respectfully requested. If the Examiner does not agree, then a personal or telephonic interview is respectfully requested to discuss any remaining issues so as to expedite the eventual allowance of the claims.

A fee is believed to be due for the presentation of new independent claims and a Fee Transmittal Sheet is submitted concurrently herewith. A fee for an extension of time also is believed to be due for this submission and a petition for extension of time is submitted concurrently herewith. Should any additional fees be required, please charge such fees to Pennie & Edmonds LLP Deposit Account No. 16-1150.

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Respectfully Submitted,

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